

Application No. : 10/609,488
Art Unit : 3731

Attorney Docket No. 22868.00
Confirmation No. 1709

REMARKS

By the present amendment, Applicants have amended Claims 1, 3 and 4, and canceled Claims 2 and 5-8. Claims 1, 3 and 4 remain pending in the present application. Claim 1 is the sole independent claim.

In the Office Action mailed October 19, 2004, the Examiner rejected Claims 1, 2, 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Clark (U.S. Patent No. 1,910,750) in view of Delaney (U.S. Patent No. 5,887,492). Claims 3, 4, 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark (U.S. Patent No. 1,910,750) in view of Delaney (U.S. Patent No. 5,887,492).

Claim 1 has been amended to more particularly define the subject matter in question and Claims 5-8 have been canceled to reduce the number issues for further consideration. With regard to the remaining claims, Applicants will advance arguments hereinbelow to illustrate the manner in which the invention defined by the newly introduced claims is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Amended independent Claim 1 is directed to a medical device for removing an hub of intravenous tubing which includes, in part, a pair of pivotally connected arms, a ring handle integrally formed at one end of each arm, a ratchet extending from each arm adjacent the ring handle, and a jaw integrally formed at an opposite end of each arm. Each ratchet is set forth as having a plurality of ratchet teeth defined therein, with the ratchets extending towards each other. The jaw, which constitutes a characteristic feature of Applicants' invention, is further defined as having a block shape with a thickness greater than the thickness of each arm, and wherein each jaw comprises an upper projection having a planar face, a lower projection having a planar face and a semicylindrical recess defined therebetween, such that when the ring handles are drawn together each jaw abuts together to form a cylindrical bore. The semicylindrical recess of each jaw is further characterized as having a plurality of teeth defined therein. Dependent Claim 3 sets forth the thickness of each jaw and Claim 4 defines the diameter of the cylindrical bore that is formed when the jaws abut together. No new matter is involved by the present amendments to the claims since the same find clear support in the written description and drawings contained in the original disclosure. Applicants contend that the combination of references relied upon of record fails to disclose or reasonably suggest a medical device having the combination of features as defined by the present claims.

In contrast to the device set forth by the present claims, the patent to Clark discloses a pair of pliers having jaws of semi-circular shape with teeth on their inner surfaces for gripping the base of a

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bulb in order to remove the bulb from an electric light socket. Clearly, the circular grip pliers of Clark is functionally unrelated to the claimed medical device and would not be capable of being used in the manner contemplated by Applicants, as described under the specification. Moreover, Clark's device is structurally distinguishable from that of Applicants' since it lacks the block-shaped jaws having the relative thickness as called for by the present claims. Also, Clark's pliers include a spring coiled about the pivot for holding the jaws separated, whereas Applicants' claimed device requires the engagement of ratchets extending from the arms in order to lock the jaws together. Further, Clark's jaws are fastened to the upper end of each arm by rivets, whereas Applicants' jaws are integrally formed at the end of each arm. In addition, Clark fails to disclose or suggest that the arm members may have a ring handle integrally formed at each arm end, as called for by the present claims.

In order to supplement the above noted deficiencies of the primary reference to Clark, the Examiner relies upon the secondary reference to DeLaney. The patent to DeLaney was relied upon by the Examiner to show a device having pivotally connected arms with ring handle grips formed thereon and serrated locking extensions adjacent the handle grips. However, unlike Applicants' claimed medical device, the pivoting arms of DeLaney's apparatus form hexagonal recesses when closed. Clearly, there appears no suggestion in the prior art that certain features of DeLaney's apparatus for gripping a hexagonal nut would be suitable for incorporating into Clark's pliers for removing a light bulb. In fact, Clark's use of a spring for normally keeping the jaws separated would

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“teach away” from using the serrated locking extensions taught by DeLaney. Moreover, the mere fact certain features of Applicants’ medical device are known in the art is insufficient basis to preclude patentability of the presently claimed invention. Furthermore, it would not be an obvious matter of design choice to fabricate the block-shaped jaws to have the thickness recited in Claim 3 or to form the cylindrical bore to have the diameter recited in Claim 4 since these dimensions are essential for achieving the purpose of Applicants’ invention, which is to provide a medical device for the removal and tightening of hubs and other connections in IV tubing.

Applicant notes that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings



concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

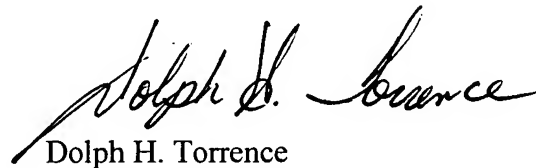
Applicants contend that one skilled in the art would not be motivated or guided by the prior art to combine these references in the manner suggested by the Examiner since the devices disclosed by the applied references are so structurally and functionally unrelated to one another as to make such a combination impractical. Moreover, Applicants further contend that even if the references were properly combinable, the above noted deficiencies of the primary reference to Clark are not remedied by the teachings afforded by the secondary reference to DeLaney. Thus, one of ordinary skill in the art without the benefit of Applicants' own disclosure would not be capable of arriving at the presently claimed invention by combining the references in the manner suggested by the Examiner since none of references cited or applied of record realistically suggests the essential combination of features that forms the basis of the instant claims.. For at least these reasons, Applicant respectfully submits that independent Claim 1, as amended, and corresponding dependent Claims 3 and 4 are allowable over the prior art of record.

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For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Dolph H. Torrence". The signature is fluid and cursive, with the first name "Dolph" being more prominent.

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DHT:RCL

Attachments: Petition to Revive Abandoned Application
Check in the Amount of \$750.00